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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 09/466,627 | Applicant(s) LO ET AL. | |
| | Examiner Maikhanh Nguyen | Art Unit 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90, and 97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE filed 02/20/2008.

Claims 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90, and 97 are currently pending. Claims 2-6, 8-9, 11-15, 17-18, 20, 23-24, 26, 29-30, 32-22, 35-36, 38-39, 41-42, 44-75, 77-83, 85-86, 88-89, and 91-96 have been cancelled. Claims 20 and 27 have been amended. Claim 97 has been added. Claim 1 is an independent claim.

Request Continuation for Examination

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 02/20/2008 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90, and 97 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under a broad but reasonable interpretation, the method claim 1 is unpatentable under section 101 because (i) it does not qualify as a “process” under section 101, as that term has been interpreted by case law, (ii) it seeks to patent an abstract idea, and (iii) the “useful, concrete, and tangible result” test does not apply here, but the claim nevertheless does not meet that test. The method claim 1 differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the steps, nor does it require any machine or apparatus to perform the steps. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing and it does not require any machine or apparatus to perform the steps. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words,

the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 1 does not specify whether the entity performing the steps of **establishing** is a computer, a human, or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claim is “so abstract and sweeping” that it would “wholly pre-empt” all applications (whether performed by a machine or a human) that are directed to create a mapping from several types of data sources to XML.

Declaration Under 37 CFR 1.131

4. The declaration under 37 CFR 1.131 filed 02/20/2008 has been considered, but it is insufficient to overcome the rejection of claims 1, 7, 10, 16, 19, 21, 22, 25, 27, 31, 34, 37, 40, 43, 84, 87, 90, and 97, under 35 U.S.C. 102(e) as being anticipated by Chang et al. (U.S. Patent No. 6584459, filed 06/1999) because: it does not establish conception or reduction to practice prior to the date of the Chang reference (see MPEP 715.07).

CONCEPTION:

Applicant presents Exhibits A-E which applicant allegedly declares to a conception to the claimed invention.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.” (see MPEP 715.07)

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm’r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.” (See MPEP 715.07)

“The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms

about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”) (See MPEP 715.07).

Applicant merely refers to Exhibits A-E as an evidence of conception. No explanation of how Exhibits support conception of the claimed invention is provided. This amounts to a general allegation and does not meet applicant’s burden of clearly explaining the exhibit “pointing out exactly what facts are established and relied upon by applicant”. The examiner has reviewed Exhibits and does not see how they would support conception. For example, the Examiner does not see Exhibits provided by Applicant would allow one of ordinary skill in the art to practice or make use of the invention nor how Exhibits relate to the claim language. This particular example is merely for illustration and is not comprehensive. Therefore, Applicant has not provided an adequate showing of conception.

REDUCTION TO PRACTICE:

Applicant presents Exhibits A-E which applicant allegedly declares to a reduction to practice of the claimed invention.

“Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose” (MPEP 715.07).

“For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development” (MPEP 2138.06).

Applicant merely refers to Exhibits A-E as an evidence of to establish actual reduction to practice or the fact that the invention worked for its intended purpose. They do not show connection between the claim limitations and Exhibits, nor describe the invention that is tested, or indication that it was testing. This is a mere general allegation of reduction to practice and is not a properly of evidence that show the invention worked or was tested. Therefore, Applicant has not provided an adequate showing of actual reduction to practice.

A written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application, which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice.

In view of the lack of presented exhibit of support as explained above, it is the examiner's opinion that the presented affidavit is insufficient proof that Applicant's invention was conceived and reduced to practice before the filing date of the Chang reference, and prior to the filing date of Applicant's invention. Applicants have not established prior invention, therefore, the rejection is maintained.

Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90, and 97 are rejected under 35 U.S.C. 102(e) as being anticipated by **Chang et al.** (U.S. 6584459, filed 06/1999, priority 10/1998).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to claim 1:

Chang teaches establishing a mapping from lists and scalars corresponding to at least one data source into XML elements and attributes [see col.19, lines 47-48 and figs.1 and 3 → associating these data types with XML elements and attributes; see figs.1 and 3 show association between DB2 with XML document; see also, the mapping discussion beginning at col.14, line 34].

As to claim 7:

Chang teaches the data source is a relational database [see col.3, lines 35- 60 and fig.1 → relational database].

As claim 10:

Chang teaches expressing the mapping in constructs of a mapping language [see the mapping discussion beginning at col.14, line 34; Figs. 1, 3 and associated text].

As to claim 16:

Chang teaches the constructs comprise at least one of a value specification [variable; see figs. 11 &12] and a binding specifications.

As to claim 19:

Chang teaches at least one parameter [col.20, line 63 → parameters]; the at least one of the constructs is adapted so that a value of the at least one of the parameters is determinable at a time of generation of at least one respective XML element associated with the at least one of the constructs [col.22, lines 18-57 and col.23, lines 5-51].

As to claim 21:

Chang teaches producing an XML document based on the mapping; and passing the value to the parameter [col.22, lines 18-57].

As to claim 22:

Chang teaches associating values and or formulas with the DTD [see the DTD discussion beginning at col.9, line 3].

As to claim 25:

Chang teaches associating one or more lists of data objects or formulas producing data objects with each DTD construct having a repetition symbol at the end [see the document type definition discussion beginning at col.5, line 50].

As to claim 27:

Chang teaches producing an XML document using a medium [col.6, line 59 → computer-readable medium] embodying a result of the associating; and responsive to performing the associating operation [col.8, lines 21-42 → perform operations on the stored XML documents].

As to claim 28:

Chang teaches the associating including one or more lists of data objects or formulas producing data objects with each DTD construct which is not a

#PCDATA, a choice list, or an attribute list, and does not end with a petition symbol [see col. 5, line 17 – col. 16, line 15].

As to claim 31:

Chang teaches associating a value or formula producing a value with each PCDATA, choice list, or attribute definition [col.24, lines 32-66].

As to claim 34:

Chang teaches associating includes, not necessarily in the following order: first associating one or more lists of data objects, or formulas producing data objects with a DTD construct [see the document type definition discussion beginning at col.5, line 50 and col. 9, line 11]; second associating at least one of the lists or formulas with at least one variable name; and using the variable name as a parameter in at least one other formula [col.24, lines 38-66].

As to claim 37:

Chang teaches associating at least one respective environment with a respective XML element to be generated [col.8, lines 31-32 → an XML table is created].

As to claim 40:

Chang teaches information from a parent XML element of the respective XML element; and information from a binding specification of a DTD construct associated with the respective XML element [col.15, line 50- col.17, line 64].

As to claim 43:

Chang teaches the mapping including at least one respective specification corresponding to at least one respective XML element; the specification comprises at least one parameter for receiving a value upon generation of an XML document; and the method further comprises, upon generation of an XML document, sending the at least one parameter a value according to at least one variable/value pair [attribute name/value pairs] in the at least one respective environment [col.15, line 25-col.16, line 24].

As to claim 76:

Chang teaches multiple heterogeneous data sources [see FileSystem 500 and DB2 300 in fig.3] and method further comprises using a pre-established DTD corresponding to the multiple heterogeneous data sources; and based on the DTD and the multiple heterogeneous data sources, adding annotations to the DTD to create an annotated DTD [col.12, lines 34-60], such that an SML document generated from the DTD is guaranteed to conform to the DTD [XML documents conform to a single DTD; col.15, lines 50-67].

As to claim 84:

Chang teaches the mapping is responsive to a user mapping specification [col.16, lines 1-22].

As to claim 87:

Chang teaches at least two data sources, and the data sources are of different types [see FileSystem 500 and DB2 300 in fig.3].

As to claim 90:

Chang teaches inserting the constructs into a DTD to create an annotated DTD [col. 9, lines 40-54 → constructor can be used to insert and update data ... the XML].

As to claim 97:

Chang teaches a DTD relating to an XML format; and annotations inserted into the DTD relating to a data source format [col. 7, line 9 – col. 8, line 42].

Response to Arguments

6. Applicant's arguments filed 02/20/2008 have been fully considered but they are not persuasive.

The declaration under 37 CFR 1.131 filed 02/20/2008 has been considered, but it is insufficient to overcome the rejection of claims 1, 7, 10, 16, 19, 21, 22, 25, 27, 28, 31, 34, 37, 40, 43, 76, 84, 87, 90, and 97, under 35 U.S.C. 102(e) as being anticipated by Chang reference.

Conclusion

7. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is

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(571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. N./

/Doug Hutton/
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